

**REMARKS:**

**CLAIM REJECTIONS**

**Double Patenting**

The Examiner has rejected claims **26, 27, and 32-34, 36 and 37** under the judicially created doctrine of double patenting over claims 1-5, 13, 14 and 26 of copending Application No. 09/834,744. The Examiner indicated that a timely filed terminal disclaimer would overcome the rejections. To expedite prosecution, the Assignee of the present application files herewith a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) along with the appropriate fee. Therefore, the Applicants submit that the rejections are overcome.

**10 35 USC 102(b)**

The Examiner has rejected claims **26-36** under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,396,975 to Wood et al. (hereinafter Wood). In rejecting claim 26, the Examiner argues that Wood discloses a method for operating a MEMS device having a flap that is movable with respect to a base, the method comprising : applying a pre-bias

**15** force to the flap to move the flap at least partially out of contact with an underlying base.

In rejecting claim **32**, the Examiner argues that Wood discloses, in figure 4b and throughout the disclosure, a microelectromechanical apparatus comprising: a base (12), a flap having a portion coupled to the base so that the flap is moveable out of the plane of the base from a first angular orientation to a second angular orientation (14), wherein the base **20** has an opening that receives the flap when the flap is in the second angular orientation (30), the opening having one or more sidewalls, wherein at least one of the sidewalls contacts a portion of the flap such that the flap assumes an orientation substantially parallel to that of the sidewall when the flap is in the second angular orientation, and a sidewall electrode disposed in one or more of the sidewalls (column 34, lines 12+).

**25** The Applicants respectfully traverse the rejection. The Applicants submit that Wood does not teach or suggest a pre-bias force as set forth in claim **26**. Instead, wood teaches a magnetic force to actuate the pop-up mirror (see col. 8, lines 53-58). The pre-bias force is separate and apart from the actuation force. Note that in the present application the

**30** discussion of the pre-bias force on page 8, lines 1-25 is separate from the discussion of the actuation force, e.g., on page 5, lines 22-31. As such, Wood does not teach or suggest all

the limitations of claim 26. Therefore claim 26 defines an invention suitable for patent protection. Furthermore, claims 27-31, depend, either directly or indirectly, from claim 26 and recite additional features therefore. As such and for the same reasons set forth with respect to claims 26 Applicants submit that these dependent claims define an invention 5 suitable for patent protection.

Furthermore, claim 32 recites that the *flap is coupled to the base* and that *the base has an opening that receives the flap*. A comparison of Wood and claim 32 reveals that Wood's sidewall is not part of an opening in the base (12). Instead, Wood's positioning structures (22) are part of a second microelectronic substrate (20) that is completely separate from the 10 base (12) (see col. 6, lines 28-39, and figures 4a-4c, 7a-7b of Wood). As such, Wood does not teach or suggest all the features of claim 32 as it presently stands in the application. Therefore, claim 32 defines an invention suitable for patent protection. Furthermore, claims 33-37, depend, either directly or indirectly, from claim 32 and recite additional features therefore. As such and for the same reasons set forth with respect to claims 32 15 Applicants submit that these dependent claims define an invention suitable for patent protection.

#### 35 USC 102(f)

The Examiner has rejected claims 26, 27, 32-34, 36, and 37 under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. The Examiner bases this 20 rejection on currently pending application 09/834,744 which names four other inventors in addition to the two inventors listed in the present application. The Examiner asserts that she is unable to determine if the present subject matter was indeed invented as presented in the instant claims.

In response, the Applicants submit that the differing inventorship between the 09/834,744 25 application and the present application does not give rise to any presumptions of inventorship that would justify a rejection under 35 USC 102(f) (see MPEP 2137). Both applications are commonly assigned and the present application claims priority to the 09/834,744 application. However, in response to the Examiner's inquiry into the inventorship of the present subject matter, Applicants Michael Daneman and Murali 30 Chaparala submit herewith declarations under 37 C.F.R. 1.132 (see MPEP 2137). In short,

the Applicants submit that they invented the subject matter of the present application without derivation from the work of the other inventors listed in application 09/834,744.

CLAIM REJECTIONS – 35 USC 103.

The Examiner has rejected claim 37 under 35 USC 103(a) as being unpatentable over  
5 Wood. In rejecting claim 37, the Examiner states that Wood discloses the use of silicon for the substrate (column 6, lines 8+), but that Wood fails to disclose the use of a silicon-on-insulator wafer. The Examiner argues that one of ordinary skill in the art at the time the invention was made would have recognized the wide use of SOI wafers in a MEMS device and it would have been obvious to use a SOI wafer because it improves the reliability of  
10 the switch while reducing the cost of manufacture.

The Applicants respectfully traverse the rejection on the grounds that Wood does not teach or suggest all of the limitations of claim 32, for the reasons set forth above. Furthermore, since Wood teaches that the sidewall is separate from the base to which the flap is attached, Wood teaches away from claim 32. Since claim 37 depends from claim 32, no  
15 combination of Wood with skill in the art teaches all the limitations of claim 37.

CONCLUSION

For the reasons set forth above, the Applicants submit that are allowable over the cited art and define an invention suitable for patent protection. The Applicants respectfully request entry of the amendment reconsideration of the application and that the Examiner issue a  
20 Notice of Allowance in the next office action.

Respectfully submitted,



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